

REMARKS

I. Status of the Application.

Claims 1-6, 9-20, and 25 of the Application were pending as of the date of the Office Action. In the Office Action, the Examiner:

- (a) Rejected claims 1-5, 11-15, 18 and 19 under 35 U.S.C. § 102(e) as allegedly being anticipated by U.S. Patent Publication No. 2003/0150909 to Markham ("Markham");
- (b) Rejected claims 6, 9, 10, 16, 17, 20, and 25 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Markham in view of U.S. Patent Number 6,421,571 to Spriggs et al. ("Spriggs"); and
- (c) Requests clarification from the Applicants on the support of the amendments made to the claims in the previous response to office action submitted by the Applicants on July 25, 2007.

Applicants respectfully submit that the foregoing amendments and the following remarks incorporated herein overcome the Examiner's rejections of the Application.

II. Applicants' Amendments Do Not Constitute New Matter.

Applicants respectfully submit that the amendments to claims 1, 12, and 20 do not constitute new matter in the Application because support for the amended claims is provided in the Application as originally filed. Therefore, because the amendments to the aforementioned claims merely act to clarify the claims in light of the specification, Applicants respectfully submit that the amendments should be accepted and entered.

III. The Rejection of Claims 1-5, 11-15, 18 and 19 Under 35 U.S.C. § 102(e), Should Be Withdrawn.

Applicants respectfully submit that the rejections of claims 1-5, 11-15, 18 and 19 under 35 U.S.C. § 102(e) should be withdrawn because Markham does not disclose all of the limitations of these claims. A rejection under section 102(e) can be overcome by showing that the prior art does not disclose all of the limitations of the claims. MPEP § 706.02(b).

As discussed in prior responses, Markham discloses a system for ensuring that a manufacturing system is operating in accordance with a prescribed budget. (para. [0002, 0009, 0049]). The Markham system allows for pre-defined key performer indicators to be set by a financial department. (para. [0049]). In addition, the Markham system provides for setting financial alerts for pre-defined events and generating a report from the information collected after the event has occurred if that information exceeds the alert. (para. [0057-0062]).

Applicants respectfully submit that Markham, including paragraph [0228], does not disclose all of the limitations of the claims. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently, in a single prior art reference." MPEP § 2131 (citing *Verdegual Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987)). Paragraph [0228] of Markham discusses the financial reports that can be generated through the financial report system 56 and discusses the ability of the user to access real time productivity measures/information to update the profitability and yield of a machine or process in such reports. (para. [0206] & [0228]). As discussed in prior responses, the Markham system continually monitors machine data for events relating to productivity and/or product quality. However, nothing in Markham, including in either paragraphs [0206] or [0228], states

that such information is automatically collected and stored in a database. Quite the contrary, Markham discusses in several portions of the disclosure that its system only collects and stores data when an "event" occurs.

Markham specifically states that its system "collects, stores, and reports production information ... on an event basis." (para. [0035]). As defined in Markham, an "event" is "any incident that may affect the productivity of a process or machine in use to produce a product, or that may adversely affect the quality of the product being produced." (para. [0036]). While the Markham system continually monitors machine data for events relating to productivity and/or product quality, it only logs (i.e. saves) production information when an event (or a certain type of event) occurs. (para. [0035]; *see also*, para. [0214] (a "trigger event" is defined as "an event requiring event data to be entered in the PIPE database")). In addition, Markham points out that "events may be spaced apart in time by time steps that typically are not constant, and may be substantially randomly spaced in time, or may be characterized in that the standard deviation of the time step between successive events is large relative to the mean." (para. [0035]). Accordingly, Applicants respectfully submit that the Markham system does not disclose the steps of automatically collecting and storing information at regular time intervals, as claimed in method claims 1-5, 11-15, 18 and 19.

Moreover, Applicants respectfully submit that Markham does not disclose the steps of setting both at least one alarm and at least one specification for the product of method claims 1-5. The Applicants have defined the term "specification" to mean "the values of a measure of a product that must not be exceeded or that must be exceeded for the user to sell the product" and the term "alarm" to mean the "values of a measure of a product that are close to and/or fall within

the range of the values of the specification." (Application, p. 13, ll. 16-21). By being close and falling within the range of the values of the specification, the alarms effectively notify a user when the measure is close to either exceeding or not exceeding the required specification. In contrast, Markham only discloses a method for defining alerts that indicate when a specified waste or delay threshold has been exceeded. (para. [0057-0062]). The system alerts in Markham are not set with regard to the product or manufacturing sub-process or with regard to the set points described in paragraph [183], but rather, are set to only define a certain threshold of waste or delay in the system that cannot be exceeded. (para. [0061]). Accordingly, Applicants respectfully submit that Markham does not disclose the steps of setting both at least one alarm and at least one specification for the product, as claimed in method claims 1-5.

For at least these reasons, Applicants respectfully submit that Markham does not disclose all of the limitations of claims 1-5, 11-15, 18 and 19 and the rejection of these claims under 35 U.S.C. § 102(e) as being anticipated by Markham should be withdrawn.

IV. The Rejections of Claims 6, 9, 10, 16, 17, 20, and 25 Under 35 U.S.C. § 103(a) As Being Obvious Over Markham In View of Spriggs Should Be Withdrawn.

Applicants respectfully submit that the rejection of claims 6, 9, 10, 16, 17, 20, and 25 under 35 U.S.C. § 103(a) should also be withdrawn because neither Markham nor Spriggs disclose all of the limitation of these claims. In making a determination of obviousness, the Examiner needs to step in the "shoes worn by the hypothetical 'person of ordinary skill in the art' when the invention was unknown and just before it was made" and determine "whether the claimed invention 'as a whole' would have been obvious at that time to that person." MPEP §2141 (8th Ed., Rev. 6) (2007) (emphasis added). In making such a determination, the Examiner

must avoid use of impermissible hindsight and "the legal conclusion must be reached on the basis of the facts gleaned from the prior art." *Id.* After performing such an analysis, the Examiner then must articulate the findings of fact concerning the state of the art and the teachings of the references applied, and should provide an explicit analysis supporting the obviousness rejection under 35 U.S.C. § 103(a) to properly establish a *prima facie* case of obviousness. *Id.*; *See also*, *KSR Int'l. Co. v. Teleflex, Inc.*, 550 U.S. ___, 127 S.Ct. 1727, 1740-41 (2007).

As explained above, Applicants respectfully submit that the Markham system does not disclose the steps of automatically collecting and storing information at regular time intervals, as claimed in method claims 6, 9, 10, 16, 17, 20, and 25. Applicants also respectfully submit that Spriggs also does not disclose, nor does the Examiner allege that Spriggs discloses, the steps of automatically collecting and storing information at regular time intervals, as claimed in method claims 6, 9, 10, 16, 17, 20, and 25. Accordingly, Applicants respectfully submit that neither Markham nor Spriggs, alone or in combination, disclose the steps of automatically collecting and storing information at regular time intervals, as claimed in method claims 6, 9, 10, 16, 17, 20, and 25.

Moreover, as explained above, Applicants respectfully submit that Markham does not disclose the steps of setting both at least one alarm and at least one specification for the product, as claimed in method claims 6, 9, 10, 16, 17, 20, and 25. Keeping the definitions of the terms specification and alarm in mind, Applicants respectfully submit that the combination of Spriggs and Markham does not yield a method that includes the steps of setting both specifications and alarms that indicate when the manufacturing sub-process is producing a product that is nearing the set specifications. Rather, the combination of Spriggs and Markham yields a method that

sets alarms that indicate when the assets or equipment need maintenance (Spriggs) and sets alerts that indicate when a specified waste or delay threshold has been exceeded after an event has occurred and information is gathered (Markham). Thus, keeping in mind that an "alarm", as defined in the Application, provides notice when a measure is close to either exceeding or not exceeding a specification, the combination of Markham and Spriggs does not disclose the steps of setting both at least one alarm and at least one specification for the product, as claimed in method claims 6, 9, 10, 16, 17, 20, and 25. Rather, the Spriggs alerts and the Markham alarms only notify an end user when an event has already occurred (e.g, when an asset needs maintenance or a specified waste threshold has been exceeded).

The steps of setting of alarms and notifying an end user when the alarms are triggered in real time are significant because it allows the user to take proactive steps to remedy any problems prior to the specifications not being met. This in turn will allow the user to prevent any faulty products from being produced. This differs from Markham which only notifies a user after a defined event and a sufficient threshold of delay and waste have occurred. The user at that time cannot do anything to prevent the delay or waste that has occurred but can merely take steps to prevent it from continuing. It also differs from Spriggs, because Spriggs only notifies a user when a machine needs maintenance and does not notify a user when a specification for the product to be sold is not being met. Thus, neither Spriggs nor Markham, alone or in combination, allow for a user to take proactive steps to ensure that specifications are met when the user is notified in real time that an alarm is triggered (i.e., a specification is being approached).

For these reasons, Applicants respectfully submit that neither Markham nor Spriggs, alone or in combination, disclose all of the limitations of claims 6, 9, 10, 16, 17, 20, and 25 and

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the rejection of these claims under 35 U.S.C. § 103(a) as being obvious over Markham in view of Spriggs should be withdrawn.

V. The Previous Amendments Are Supported by the Application.

Applicants respectfully state that the previous amendments made in Applicants' July 25, 2007 Response are supported by the Application, as originally filed. For example and among other places, the previous amendments are supported on page 3, lines 13-23, page 4, lines 1-10; page 19, lines 1-13; page 22, lines 18-23; and p. 23, lines 1-6. Accordingly, Applicants respectfully submit that the Examiner's request for clarification of support of the previous amendments has been satisfied.

VI. Applicants Petition for an Extension of Time and Request for Continued Examination.

Applicants hereby petition for an extension of time of three (3) months, under 37 C.F.R. § 1.136(a), thereby extending the deadline for response, pursuant to 37 C.F.R. §§ 1.7(a) & 1.136(a), to Tuesday, March 11, 2008. Applicants also request continued examination by submitting a Request for Continued Examination transmittal form, this response and payment of the filing fee of \$810.00. Applicants authorize payment for this extension of time in the amount of \$1,050.00 and for this request for continued examination in the amount of \$810.00 to be charged to the identified credit card. When doing so, please reference the above-listed docket number for this file.

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CONCLUSION

For all of the foregoing reasons, it is respectfully submitted that claims 1-6, 9-20, and 25 are allowable claims and Applicants have made a patentable contribution to the art. Favorable reconsideration and allowance of this Application is therefore respectfully requested. In the event the Applicants have inadvertently overlooked the need for payment of an additional fee, Applicants conditionally petition therefore, and authorize any deficiency to be charged to deposit account 09-0007. When doing so, please reference the above-listed docket number.

Respectfully submitted,

ICE MILLER LLP



Alexander D. Forman, #51,691

ICE MILLER LLP

One American Square

Suite 3100

Indianapolis, IN 46282-0200

Telephone: (317) 236-5826

Facsimile: (317) 592-5433

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